



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Shmuel Shaffer et al.
Serial No.: 10/020,102
Filing Date: December 13, 2001
Group Art Unit: 2654
Examiner: Angela A. Armstrong
Title: TEXT TO SPEECH SYSTEM AND METHOD
HAVING INTERACTIVE SPELLING
CAPABILITIES

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. The Applicants respectfully request reconsideration of the Application in light of the remarks set forth below.

REMARKS

Applicants contend that the rejection of Claims 1-37 on prior art grounds contain clear legal and factual deficiencies, as described below. In a Final Office Action dated December 15, 2005, Claims 1-8, 10-16, 32-33, and 35-36 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,799,273 issued to Mitchell et al. ("*Mitchell*") in view of U.S. Patent Application Publication No. 2001/0013001 issued to Brown et al. ("*Brown*"). Claims 9, 17-31, 34, and 37 under 35 U.S.C. § 103(a) as being unpatentable over *Mitchell* in view of U.S. Patent No. 6,068,487 issued to Dionne ("*Dionne*") and further in view of U.S. Patent No. 6,424,357 issued to Frulla et al. ("*Frulla*"). Applicants request a finding that these rejections are improper and allowance of these claims.

A. Claims 1-8, 10-16, 32-33, and 35-36

With respect to Claims 1-8, 10-16, 32-33, and 35-36, the Final Office Action of December 15, 2005 ("Final Office Action") contends that the proposed *Mitchell-Brown* combination is a proper combination and discloses each and every limitation of Applicants' independent claims. In response to the Final Office Action, Applicants provided a detailed summary of the standard for establishing a *prima facie* case of obviousness based on a combination of prior art references. This summary is described in Applicants' Response dated February 14, 2006 at Pages 10-12 under the heading "The Standard." Additionally, Applicants argued that the *Mitchell-Brown* combination is an improper combination since (1) it is not sufficient for an Examiner to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine that reference with other references simply based on that advantage and (2) one of ordinary skill in the art at the time of Applicants' invention would not have been motivated to make the proposed combination since *Brown* is outside the field of technology of *Mitchell* and the objectives of the respective systems are vastly different. These positions are described more fully in the cited portions of Applicants' Response dated February 14, 2006, at Pages 12-15 under the heading "The Analysis [of Claims 1-8, 10-16, 32-33 and 35-36]."¹

¹ It is noted in the OG Notice at <http://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm> that "Applicants are encouraged to refer to arguments already of record rather than repeating them in the request." Accordingly, Applicants refer here to, and summarize, the previous arguments rather than reciting them explicitly.

The Advisory Action mailed February 28, 2006, addressed such remarks stating:

Mitchell does not teach transmitting audio to a telecommunication device to play an audio file to a user. However, the feature of transmitting audio to a telecommunication device to allow playback of an audio file to a user was well known in the art. In a similar field of endeavor Brown discloses a platform for implementing interactive voice response (IVR) applications over the Internet or other type of network . . . One of ordinary skill in the art would have the knowledge and clearly recognize the advantages of modifying the system of Mitchell to implement an interactive voice response system as suggested by Brown to allow for Internet information access via a telephone, as also suggested by Brown.

Applicants respectfully contend, however, that the Examiner's argument in the Advisory Action is clearly flawed for the same reasons that the Examiner's argument in the Final Office Action was flawed.

Specifically, Applicants disagree with Examiner's contention that the system of *Brown* is "in a similar field of endeavor" as *Mitchell*. In the Response to Office Action filed February 14, 2006, Applicants demonstrated the many differences in the respective systems of *Mitchell* and *Brown* and in the objectives sought to be achieved by the systems of *Mitchell* and *Brown*. Namely, *Mitchell* is related to a speech recognition engine that allows audio playback of data which has been dictated and edited. (*Mitchell*, Column 1, lines 59-67). This objective is very different from the objective of *Brown*, which is to provide Internet-based content by way of a telephone. (*Brown*, Page 1, paragraph 2). Applicants position is discussed in more detail in Applicants' Response dated February 14, 2006, at Pages 12-15 under the heading "The Analysis [of Claims 1-8, 10-16, 32-33 and 35-36].

Furthermore, Applicants submit that, like the Final Office Action before it, the Examiner's response to Applicants' arguments in the Advisory Action mailed February 28, 2006 does not provide the required evidence for supporting the proposition that one of ordinary skill in the art at the time of Applicants' invention would have been motivated to combine these disjointed portions of unrelated references (without the use of hindsight) in an attempt to reconstruct Applicants' claims. The Examiner's arguments in the Advisory Action merely state a proposed advantage of *Brown* and then summarily conclude that one of ordinary skill in the art would have been motivated to incorporate the features of *Brown* into the system of *Mitchell* for the advantage purportedly provided by *Brown*. Applicants submit

that the Examiner's conclusions, however, are not evidence of the required motivation to combine since the conclusions do not explain why one of ordinary skill in the art would have been motivated to modify the particular techniques disclosed in *Mitchell*, how one of ordinary skill in the art at the time of Applicants' invention would have actually done so, and how doing so would purportedly meet the limitations of Applicants' claims. Accordingly, Applicants' submit that the rejection of Applicants' claims is legally and factually flawed.

B. Claims 9, 17-31, 34, and 37

With respect to Claims 9, 17-31, 34, and 37 the Final Office Action of December 15, 2005 ("Final Office Action") contends that the proposed *Mitchell-Dionne-Frulla* combination is a proper combination and discloses each and every limitation of Applicants' independent claims. In response to the Final Office Action, Applicants argued that the *Mitchell-Dionne-Frulla* combination is an improper combination since (1) it is not sufficient for an Examiner to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine that reference with other references simply based on that advantage, (2) the motivations provided by the Examiner do not provide a suggestion to combine these three references, and (3) one of ordinary skill in the art at the time of Applicants' invention would not have been motivated to make the proposed combination since *Dionne* is outside the field of technology of *Mitchell* and the objectives of the respective systems are vastly different. These positions are described more fully in the cited portions of Applicants' Response dated February 14, 2006, at Pages 15-18 under the heading "Claims 9, 17-31, 34, and 37."

The Advisory Action mailed February 28, 2006, addressed such remarks stating:

. . . Dionne specifically teaches that the system is useful in assisting individuals with learning disabilities or severed visual impairments, and one of ordinary skill would clearly recognize the desirability of providing such individuals with text editing assistance so as to have a reading machine spell a word and provide an text-to-speech output of the word.

Again, Applicants respectfully contend that the Examiner's argument in the Advisory Action is clearly flawed for the same reasons that the Examiner's argument in the Final Office Action was flawed.

Specifically, Applicants disagree with Examiner's contention that one of ordinary skill in the art would clearly recognize the desirability of providing individuals with learning disabilities or severe visual impairments with text editing assistance so as to have a reading machine spell a word and provide an text-to speech output of the word. In the Response to Office Action filed February 14, 2006, Applicants demonstrated the many differences in the respective systems of *Mitchell* and *Dionne* and in the objectives sought to be achieved by the respective systems of *Mitchell* and *Dionne*. Specifically, and as stated above, *Mitchell* is related to a speech recognition engine that allows audio playback of data which has been dictated and edited. (*Mitchell*, Column 1, lines 59-67). Thus, the system of *Mitchell* is merely a modification of dictating software such as DragonDictate. The objectives of dictation software are very different from the objectives of *Dionne*, which is to provide a speller feature for individuals with learning disabilities or visual impairments. Applicants position is discussed in more detail in Applicants' Response dated February 14, 2006, at Pages 15-18 under the heading "Claims 9, 17-31, 34, and 37."

Furthermore, Applicants submit that, like the Final Office Action before it, the Examiner's response to Applicants' arguments in the Advisory Action mailed February 28, 2006 does not provide the required evidence for supporting the proposition that one of ordinary skill in the art at the time of Applicants' invention would have been motivated to combine these disjointed portions of unrelated references (without the use of hindsight) in an attempt to reconstruct Applicants' claims. The Examiner's arguments in the Advisory Action merely state a proposed advantage of *Dionne* and then summarily conclude that one of ordinary skill in the art would have been motivated to incorporate the features of *Dionne* into the system of *Mitchell* for the advantage purportedly provided by *Dionne*. Applicants submit that the Examiner's conclusions, however, are not evidence of the required motivation to combine since the conclusions do not explain why one of ordinary skill in the art would have been motivated to modify the particular techniques disclosed in *Mitchell*, how one of ordinary skill in the art at the time of Applicants' invention would have actually done so, and how doing so would purportedly meet the limitations of Applicants' claims. Accordingly, Applicants' submit that the rejection of Applicants' claims is legally and factually flawed.

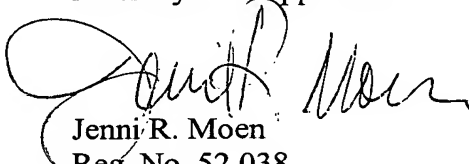
C. Arguments Not Responded to in the Final Office Action or Advisory Action

With respect to Claim 35, Applicants have repeatedly argued that *Mitchell* does not disclose, teach, or suggest “for each audio file, storing information relating the audio file to the corresponding textual word, the information comprising an electronic marker within the audio file that indicates the position of the audible word within the text file,” as recited in independent Claim 35. Because the Examiner has not responded to Applicants’ arguments in the Response to Office Action mailed September 22, 2005, the Response to Office Action mailed December 15, 2005, or the Advisory Action mailed February 28, 2006, Applicants submit that the rejection of Claim 35 is legally and factually flawed. Additionally, Applicants believe that Applicants’ arguments with respect to the recited limitation continue to have merit. These positions are described more fully in the cited portions of Applicants’ Response dated February 14, 2006, at Pages 18-19 under the heading “Arguments Not Responded to in the Final Office Action.”

CONCLUSION

As the rejections of Claims 1-37 contain clear deficiencies, Applicants respectfully request a finding of allowance of Claims 1-37. To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,
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